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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/185,208	11/03/1998	MARK E. FAGAN	54537USA3A	5148
32692	7590	06/02/2005	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			AHMAD, NASSER	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/185,208	FAGAN ET AL.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Rejections Maintained

1. Claims 1-2, 4, 7-8 and 10 rejected under 35 USC 103(a) as being unpatentable over Butler in view of Zhu for reasons of record in the last Office Action, paragraph-4, mailed on November 26, 2004.
2. Claims 5-6 and 9 rejected under 35 USC 103(a) as being unpatentable over Butler in view of Zhu and Blackwell for reasons of record in the last Office Action, paragraph-5.
3. Claims 1-2 and 4-10 rejected under 35 USC 112, first paragraph for reasons of record in the last Office Action, paragraph-7.

Response to Arguments

4. Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive.

Applicant argues that the new matter rejection should be withdrawn because the specification recites that "the particle diameter is in the range of the topographical feature of the textured film", that an embodiment in the specification exemplifies that the diameter is typically in the range of 1 to 10 micrometers, and that one skilled in the art can resort to various known analytical methods to determine the surface topography and thus can determine the appropriate particle size for the particular fillers. These are

Art Unit: 1772

not found to be convincing because the claimed phrase, for reasons as stated in the last Office Action, fails to have support in the specification as originally filed.

Applicant also argues that one skilled in the art familiar with the disclosures of Butler and Zhu would not have used Zhu to modify Butler to arrive at applicants' invention because Butler teaches pattern coating of a specific composite system and that Zhu teaches the use of colloidal silica particle to increase the abrasion resistance, and that combining of Zhu with Butler would impart abrasion resistance to the coating and may affect visual appearance. This is not deemed to be persuasive because Butler clearly teaches that the LAB layer includes particulate filler and that Zhu was cited to show that the use of particulate that can be larger in diameter than the thickness of the coat to provide for surface texture. It is unclear as to how the claimed textured film would be different than the textured film as taught by Butler when modified by Zhu's use of particle size larger than the thickness of the coat layer. Also, Zhu clearly teaches that the visual appearance of the coat is dependant on the particle size and the incorporation of other components such as fillers in col. 5, lines 29-32. Further, applicant has failed to provide any evidence that the use of only particle with diameter greater than the coat layer thickness in Butler would affect the visual appearance. Applicant has also failed to show that the instant claimed invention would not exhibit abrasion resistance surface when coated with the composition having particle diameter greater than the thickness of the coat itself.

In response to applicants' argument that Blackwell does not cure the deficiencies of Butler and Zhu as it is silent to the use of particulate fillers with LABs to create visibly

Art Unit: 1772

uniform coating. This is not found to be persuasive because Blackwell was cited to show that it is known in the adhesive art to provide strips in the stacked form of a pad.

Further, the above grounds of explanation apply *a fortiori* herein.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is found to contain new matter or would have been obvious over the prior art of record discussed above.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

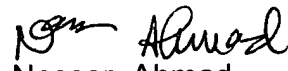
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

Art Unit: 1772

1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
May 30, 2005.